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09/589,084	06/08/2000	Yoshikazu Kobayashi	071671/0153	9809

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EXAMINER

LAFORGIA, CHRISTIAN A

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 10/30/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/589,084

Applicant(s)

KOBAYASHI, YOSHIKAZU

Examiner

Christian La Forgia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. The amendment filed on 14 August 2003 is noted and made of record.
2. Claims 1 through 18 are presented for examination.

#### ***Drawings***

3. Applicant is reminded that the Patent and Trademark Office no longer makes drawing changes and that it is applicant's responsibility to ensure that the drawings are corrected, if needed, in accordance with the instructions set forth in Paper No. 03 mailed on 14 May 2003.

#### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1 through 18 have been considered but are moot in view of the new ground(s) of rejection.
5. See further rejection that follows.

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Regarding claims 2, 3, and 9 through 18, the phrase "at least" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "at least"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

#### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 through 5 and 7 through 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,628,767 to Wellner et al., hereinafter Wellner, in lieu of obviousness.

10. As per claim 1, Wellner teaches a telephone communication system comprising:  
a public network (Figure 1 [blocks 23, 25]; column 4, lines 13-18),  
an internet service provider network (Figure 1 [block 19]; column 4, lines 13-18), and  
a plurality of telephone sets accommodated in the public network (Figure 1 [blocks 27, 65]; column 4, lines 19-28; column 4, lines 51-64),

wherein when a calling telephone set, which is a subscriber to the internet service provider network, provides connection point data for making internet service telephone communication to a called telephone set via the public network, the called telephone set receiving the connection point data connects itself to the internet service provider network according to the connection point data, and the calling telephone set connects itself to the internet service provider network (Figures 1 [blocks 27, 35, 65], 2 [block 71, 77], 4, 6; column 4, lines 35-50; column 4, line 65 to column 5, line 15; column 8, lines 17-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the abovementioned service along with an Internet service provider. One would be motivated to do so because such a service would provide a robust solution to the problems facing small/home offices. The abovementioned service would provide a simple solution for managing both high speed Internet and telephone. Furthermore, the connection information can either be drawn to the phone number and PIN number or the email with the web address and PIN number to access the call. Still further, the call takes place over the service provider's network, but as one of

ordinary skill in the art would recognize, it must traverse a public network, such as the Internet or a public switch telephone network (PSTN), to reach the respective end users.

11. As per claim 2, Wellner teaches a telephone communication system comprising:  
a public network (Figure 1 [blocks 23, 25]; column 4, lines 13-18),  
an internet service provider network (Figure 1 [block 19]; column 4, lines 13-18), and  
a plurality of telephone sets accommodated in the public network (Figure 1 [blocks 27, 65]; column 4, lines 19-28; column 4, lines 51-64),

wherein when a calling telephone set, which is a subscriber to the internet service provider network provides connection point data for making internet service telephone communication to a called telephone set via the public network, the called telephone set receiving the connection point data connects itself to the internet service provider network according to the connection point data, and the calling telephone set connects itself to the internet service provider network (Figures 1 [blocks 27, 35, 65], 2 [block 71, 77], 4, 6; column 4, lines 35-50; column 4, line 65 to column 5, line 15; column 8, lines 17-67),

the connection point data including at least an IP address in the internet service provider network and a telephone number of a point to be connected to the internet service provider network (column 5, lines 8-15; column 8, lines 9-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the abovementioned service along with an Internet service provider. One would be motivated to do so because such a service would provide a robust solution to the problems facing small/home offices. The abovementioned service would provide a simple solution for managing both high speed Internet

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and telephone. Furthermore, the connection information can either be drawn to the phone number and PIN number or the email with the web address and PIN number to access the call. Still further, the call takes place over the service provider's network, but as one of ordinary skill in the art would recognize, it must traverse a public network, such as the Internet or a public switch telephone network (PSTN), to reach the respective end users.

12. As per claim 3, Wellner teaches a telephone communication system comprising:  
a public network (Figure 1 [blocks 23, 25]; column 4, lines 13-18),  
an internet service provider network (Figure 1 [block 19]; column 4, lines 13-18), and  
a plurality of telephone sets accommodated in the public network (Figure 1 [blocks 27, 65]; column 4, lines 19-28; column 4, lines 51-64),

wherein when a calling telephone set, which is a subscriber to the internet service provider network provides connection point data for making internet service telephone communication to a called telephone set via the public network, the called telephone set receiving the connection point data connects itself to the internet service provider network according to the connection point data, and the calling telephone set connects itself to the internet service provider network (Figures 1 [blocks 27, 35, 65], 2 [block 71, 77], 4, 6; column 4, lines 35-50; column 4, line 65 to column 5, line 15; column 8, lines 17-67),

the connection point data including at least an IP address in the internet service provider network and the telephone number of a point to be connected to the internet service provider network (column 5, lines 8-15; column 8, lines 9-67),

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a push-button telephone set having various function keys being provided between each of the plurality of telephone sets and the public network with a function of sending out a call from each telephone set (Figure 1 [blocks 27, 65]; column 4, lines 19-28; column 4, lines 51-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the abovementioned service along with an Internet service provider. One would be motivated to do so because such a service would provide a robust solution to the problems facing small/home offices. The abovementioned service would provide a simple solution for managing both high speed Internet and telephone. Furthermore, the connection information can either be drawn to the phone number and PIN number or the email with the web address and PIN number to access the call. Still further, the call takes place over the service provider's network, but as one of ordinary skill in the art would recognize, it must traverse a public network, such as the Internet or a public switch telephone network (PSTN), to reach the respective end users. Additionally, it is inherent for the plurality of telephone sets to have various function keys, as most phones provide for various functions such as placing a call on hold or transferring a call.

13. Regarding claims 4, 11, and 12, Wellner teaches wherein functions of each telephone set are executed on a personal computer (Figure 1 [block 29]; column 4, lines 19-28; column 10, lines 55-60).

14. Regarding claims 5, 13, and 14, Wellner teaches wherein functions of each telephone set are executed with an IVR (interactive voice response) unit or a facsimile data server or a voice recognition dialer or a voice mail (Figure 1 [block 29]; column 4, lines 19-28; column 5, lines

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41-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to execute the telephone functions by one of the abovementioned techniques. One would be motivated to allow for these functions as it would allow participants to view and control their calls in a convenient and inexpensive manner.

15. Regarding claims 7, 17, and 18, Wellner teaches wherein each telephone set further comprises an encryption unit for permitting exchange of connection point data in terms of ciphers (column 6, lines 25-26; column 6, lines 29-38).

16. As per claim 8, Wellner teaches an Internet communication method comprising steps of: providing, by a calling telephone set that is a subscriber to an internet service provider network, of connection point data for making internet service telephone communication to a called telephone set via a public network (Figures 1 [blocks 27, 35, 65], 2 [block 71, 77], 4, 6; column 4, lines 35-50; column 4, line 65 to column 5, line 15; column 8, lines 17-67),

the called telephone set receiving the connection point data and connecting to the internet service provider network on the basis of the connection point data (Figures 1 [blocks 27, 35, 65], 2 [block 71, 77], 4, 6; column 4, lines 35-50; column 4, line 65 to column 5, line 15; column 8, lines 17-67), and

the calling telephone set connecting to the internet service provider network (Figures 1 [blocks 27, 35, 65], 2 [block 71, 77], 4, 6; column 4, lines 35-50; column 4, line 65 to column 5, line 15; column 8, lines 17-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the abovementioned service along with an Internet



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service provider. One would be motivated to do so because such a service would provide a robust solution to the problems facing small/home offices. The abovementioned service would provide a simple solution for managing both high speed Internet and telephone. Furthermore, the connection information can either be drawn to the phone number and PIN number or the email with the web address and PIN number to access the call. Still further, the call takes place over the service provider's network, but as one of ordinary skill in the art would recognize, it must traverse a public network, such as the Internet or a public switch telephone network (PSTN), to reach the respective end users.

17. As per claim 9, Wellner teaches an Internet communication method comprising steps of: providing, by a calling telephone set that is a subscriber to an internet service provider network, of connection point data for making internet service telephone communication to a called telephone set via a public network (Figures 1 [blocks 27, 35, 65], 2 [block 71, 77], 4, 6; column 4, lines 35-50; column 4, line 65 to column 5, line 15; column 8, lines 17-67),

the called telephone set receiving the connection point data and connecting to the internet service provider network on the basis of the connection point data (Figures 1 [blocks 27, 35, 65], 2 [block 71, 77], 4, 6; column 4, lines 35-50; column 4, line 65 to column 5, line 15; column 8, lines 17-67), and

the calling telephone set connects itself to the internet service provider network (Figures 1 [blocks 27, 35, 65], 2 [block 71, 77], 4, 6; column 4, lines 35-50; column 4, line 65 to column 5, line 15; column 8, lines 17-67),

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the connection point data including at least an IP address in the internet service provider network and a telephone number of a point to be connected to the internet service provider network (column 5, lines 8-15; column 8, lines 9-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the abovementioned service along with an Internet service provider. One would be motivated to do so because such a service would provide a robust solution to the problems facing small/home offices. The abovementioned service would provide a simple solution for managing both high speed Internet and telephone. Furthermore, the connection information can either be drawn to the phone number and PIN number or the email with the web address and PIN number to access the call. Still further, the call takes place over the service provider's network, but as one of ordinary skill in the art would recognize, it must traverse a public network, such as the Internet or a public switch telephone network (PSTN), to reach the respective end users.

18. As per claim 10, Wellner teaches an Internet communication method comprising steps of:

providing, by a calling telephone set that is a subscriber to an internet service provider network, of connection point data for making internet service telephone communication to a called telephone set via a public network (Figures 1 [blocks 27, 35, 65], 2 [block 71, 77], 4, 6; column 4, lines 35-50; column 4, line 65 to column 5, line 15; column 8, lines 17-67),

the called telephone set receiving the connection point data and connecting to the internet service provider network on the basis of the connection point data (Figures 1 [blocks 27, 35, 65], 2 [block 71, 77], 4, 6; column 4, lines 35-50; column 4, line 65 to column 5, line 15; column 8, lines 17-67), and

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the calling telephone set connecting to the internet service provider network (Figures 1 [blocks 27, 35, 65], 2 [block 71, 77], 4, 6; column 4, lines 35-50; column 4, line 65 to column 5, line 15; column 8, lines 17-67),

the connection point data including at least an IP address in the internet service provider network and a telephone number of a point to be connected to the internet service provider network (column 5, lines 8-15; column 8, lines 9-67),

a push-button telephone set having various function keys being provided between each of the plurality of telephone sets and the public network with a function of sending out a call from each telephone set (Figure 1 [blocks 27, 65]; column 4, lines 19-28; column 4, lines 51-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the abovementioned service along with an Internet service provider. One would be motivated to do so because such a service would provide a robust solution to the problems facing small/home offices. The abovementioned service would provide a simple solution for managing both high speed Internet and telephone. Furthermore, the connection information can either be drawn to the phone number and PIN number or the email with the web address and PIN number to access the call. Still further, the call takes place over the service provider's network, but as one of ordinary skill in the art would recognize, it must traverse a public network, such as the Internet or a public switch telephone network (PSTN), to reach the respective end users.

19. Claims 6, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wellner in view of United States Patent No. 6,222,859 to Yoshikawa, hereinafter Yoshikawa.

20. Regarding claims 6, 15 and 16, Wellner teaches:

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a telephone set control unit for detecting depressed push-buttons in the ten-key unit, obtaining the connection point data from the accumulating unit, sending out dial data and connection point data via the public network, starting the voice codec when the dialed side has been connected to the internet service provider network and, upon arrival of a call, retrieving the connection point data of the calling side, effecting connection to the internet service provider network by retrieving and referring to the accumulating unit according to the connection point data and informing the calling side of the connection (Figures 1 [blocks 27, 35, 65], 2 [block 71, 77], 4, 6; column 4, lines 35-50; column 4, line 65 to column 5, line 15; column 8, lines 17-67).

21. Wellner does not teach:

a ten-key unit having dial keys and a function key for indicating an internet telephone service;

a display unit for displaying a call arrival notification and results of various processes in the telephone set;

an accumulating unit for storing telephone number data and access identifier data of internet connection points to be connected by the calling and called sides;

a voice codec to be started by a command for voice communication in the internet service provider network.

22. Yoshikawa teaches wherein each telephone set comprises:

a ten-key unit having dial keys and a function key for indicating an internet telephone service (Figure 4 [block 14]; column 6, lines 20-42);

a display unit for displaying a call arrival notification and results of various processes in the telephone set (Figure 4 [block 15]; column 6, lines 32-42);

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an accumulating unit for storing telephone number data and access identifier data of internet connection points to be connected by the calling and called sides (column 8, lines 31-48; column 9, lines 51-67; column 11, lines 27-40; column 13, lines 15-38);

a voice codec to be started by a command for voice communication in the internet service provider network (Figure 4 [block 18]; column 6, lines 52-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the telephone sets of Yoshikawa. One would be motivated to include such telephone sets as they provide more functions that may be incorporated in an Internet telephone than just a regular telephone.

***Conclusion***

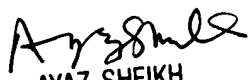
23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian La Forgia whose telephone number is (703) 305-7704. The examiner can normally be reached on Monday thru Thursday 7-5.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (703) 305-9648. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

25. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Christian La Forgia  
Patent Examiner  
Art Unit 2131

clf

  
AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
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